

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN M. PILTINGSRUD

Appeal No. 2000-0078
Application 08/837,242¹

ON BRIEF

Before CALVERT, ABRAMS and BAHR, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to
4, 8 to 14, and 25 to 29. Claims 5 to 7, 15 to 24 and 30 to
37, the

¹ Application for patent filed April 10, 1997.

Appeal No. 2000-0078
Application No. 08/837,242

other claims in the application, have been indicated as allowable.²

The claims on appeal are drawn to an assembly for use with a window. Claim 26 is representative, and reads:

26. An assembly for use with a window including a window sash movably mounted to a window jamb, the assembly for selectively locking the window sash closed against the window jamb, the assembly comprising:

a cam member for securing to the window jamb;

a keeper for mounting to the window sash and being movable relative to the window sash;

drive means for mounting to the window sash for operably controlling movement of said keeper to selectively engage the keeper with the cam member when the window sash is substantially closed against the window jamb.

The references applied in the final rejection are:

Douglas	4,500,122	Feb. 19, 1985
Nolte et al. (Nolte)	4,991,886	Feb. 12, 1991
Miilu	5,058,939	Oct. 22, 1991
Wydler et al. (Wydler)	5,480,198	Jan. 2, 1996

² In the final rejection (Paper No. 5), claims 1 to 37 were rejected under 35 U.S.C. § 112, second paragraph. After an amendment was filed on October 19, 1998 (Paper No. 7), the examiner issued an Advisory Action (Paper No. 9) to the effect that that rejection had been overcome, but that claims 26 to 28 remained rejected under § 112, second paragraph, on another ground.

Appeal No. 2000-0078
Application No. 08/837,242

The appealed claims stand finally rejected on the following

grounds:

(1) Claims 26 to 28, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph;

(2) Claims 1, 8, 10, 11, 26 and 29, anticipated by Miilu, under 35 U.S.C. § 102(b);

(3) Claim 26, anticipated by Douglas, under 35 U.S.C. § 102(b);

(4) Claims 1 to 4, 8 to 14, 25, 26 and 29, unpatentable over Nolte in view of Wydler, under 35 U.S.C. § 103(a).

Rejection (1)

As stated in In re Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997), quoting In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994):

[a]lthough paragraph six [of 35 U.S.C. § 112] statutorily provides that one may use means-plus function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language.

Appeal No. 2000-0078
Application No. 08/837,242

If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

In the present case, the examiner contends that claim 26 does not comply with § 112, second paragraph, because "[i]t is not clear what structure applicant's limitation of 'drive means, . . . for operably controlling movement of said keeper' refers to" (final rejection, page 3), and the specification "does not allow the exact scope and meaning of the claimed 'drive means' to be determined" (answer, page 3).

We do not agree with the examiner. As pointed out by appellant on page 8 of the brief, page 6 of the specification, lines 2 and 3, discloses that motor 64 has an output drive shaft 66 operatively connected to keeper 48 via reduction gear set 68. We also note that it is disclosed in lines 20 to 23 of the same page that operation of the motor causes the keeper 48 to selectively engage the cam member 26 to lock the sash 12 in a closed position, and in lines 2 to 6 of page 8 that motor 64 is controlled by control 120 to raise and lower the keeper

48. In view of this disclosure, in particular, we consider that the specification adequately shows what is meant by the claimed "drive means," since it shows that the "corresponding structure

. . . described in the specification" (§ 112, sixth paragraph) which performs the recited function of the "drive means" is the control 120, motor 64, and reduction gear set 68 (including rack 96).

Accordingly, rejection (1) will not be sustained.

Rejection (2)

The Miilu patent, on which this rejection is based, discloses apparatus for latching an automobile convertible top 110 to the windshield header 112. A motor 214 mounted on a rail 202 of the top causes a keeper 234 to pivot, thereby engaging the header at 236 when the top is closed against the header (Fig. 2). The examiner identifies Miilu's element 236 as corresponding to the appellant's recited cam member.

Appellant's arguments are set forth on pages 9 to 13 of the brief and pages 3 and 4 of the reply brief. In essence, appellant argues that the claims are not anticipated because

Appeal No. 2000-0078
Application No. 08/837,242

the recitations concerning the window sash and window jamb must be given weight.

It is fundamental that in order to anticipate a claim, "a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). However, "[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." Id. The law of anticipation does not require that a reference "teach" what appellant teaches, but only that the claims "read on" something disclosed in the reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 722, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Applying these principles with regard to the recitations in

claim 26, it is evident that, as outlined above, Miilu discloses

a cam member 236, a keeper 234, and a drive means consisting

of motor 214, gear train 216, etc., for controlling movement of the keeper to selectively engage it with the cam member. Miilu does not disclose that the cam member is secured to a window jamb, or that the keeper and drive means are mounted on a window sash, but the claim does not recite that these elements are so secured or mounted, but only that the cam member is "for securing to the window jamb" and the keeper and drive means are "for mounting to the window sash." Appellant argues that the references in the claims to the window sash and jamb are "positive limitations as to the structure and function of the invention" and "not simply statements of an intended use of the product" (brief, page 11), citing In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).³ However, in Stencel, which involved a question of obviousness rather than anticipation, the claims (claim 1 is reproduced) did not recite that the various elements were "for"

³ Appellant also attaches to his brief a copy of § 16A of Landis On Mechanics of Patent Claim Drafting (4th Ed. 1996), but no decisional or other authority is cited therein, and it is not persuasive; in fact, in the summary on page III-11, Landis recommends inferentially claiming elements not likely to be made and/or sold by the patentee, because "[t]his broadens the claim scope by not including [such] elements."

certain uses, whereas present claim 26 does so. In our view, the recitations of "for securing" and "for mounting" are no more than statements of intended use of the claimed cam member, keeper, and drive means, which do not make a claim to the combination of those items patentable. In re Schreiber, supra. We note moreover with regard to the drive means that an element expressed in terms of a means plus function is anticipated by structure in a reference which is capable of performing the functional limitation of the claimed means. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984). Here it appears evident that the drive means disclosed by Miilu would be capable of performing the function therefor recited in claim 26, since it operates to engage the keeper 234 with the cam member 236 when the top is closed against the header and a switch (col. 2, lines 38 to 42) is activated.⁴

Accordingly we conclude that claim 26, and claim 29

⁴ Although not argued by appellant, we note that the drive means disclosed by Miilu, i.e., motor 214, gear train 216, etc., is the equivalent, under § 112, sixth paragraph, of appellant's disclosed drive means. See Donaldson, supra.

dependent thereon, are anticipated by Miilu. For similar reasons, claims 1 and 11 are likewise anticipated, the various elements recited therein being disclosed by Miilu.

Claim 8, dependent on claim 1, recites "a frame, . . . , said motor and said operably connecting means disposed in said frame." Miilu discloses a "simple generally flat mounting base 204" (col. 2, lines 26 and 27) connected to the side rail 202 and having upstanding bosses 212, 222 and 224. As shown in Fig. 2,

the motor 214 extends from boss 212, the gear train is located between bosses 212 and 224, and the threaded spindle 228 extends between bosses 222 and 224, with other parts 226, 228, etc. of the apparatus connecting the motor to the keeper 234 extending

above and beyond boss 222 and guide block 230. Assuming that members 204, 212, 222, 224 and 230 of Miilu constitute a "frame"

(the examiner refers only to element 212), we do not consider that Miilu's motor and connecting means can be considered to be "disposed in said frame" (emphasis added), as recited in claim 8.

We therefore will not sustain rejection (2) as to claim 8, or as to its dependent claim 10, but will sustain rejection (2) as to claims 1, 11, 26 and 29.

Rejection (3)

The sixth paragraph of 35 U.S.C. § 112 provides that if a claim contains an element expressed as a means plus function, the claim "shall be construed to cover the corresponding structure

. . . described in the specification and equivalents thereof"; this provision is applicable to claims before the Patent and Trademark Office. Donaldson, supra. As discussed in connection with rejection (1), appellant's disclosed structure which corresponds to the drive means recited in claim 26 is the controller 120, motor 64, and reduction gear set 68.

Turning to the Douglas reference applied in rejection (3), we will assume arguendo that, as postulated by the examiner, the edge of 14 constitutes a "cam member," and hole 26 (more accurately, moveable rail 23 containing keyhole opening 25) is a "keeper." The rail 25 is moved by manual operation of handle 29, which rotates spindle 30. These items do not constitute the claimed "drive means" unless they are

Appeal No. 2000-0078
Application No. 08/837,242

equivalents under § 112, sixth paragraph, of appellant's controller, motor and reduction gear set. In Odetics, Inc. v. Storage Technology Corp.,

185 F.3d 1259, 1267, 51 USPQ2d 1225, 1230 (Fed. Cir. 1999), the court stated:

Structural equivalence under § 112, ¶ 6 is met only if the differences are insubstantial, see Chiuminatta,⁵ 145 F.3d at 1308, 46 USPQ2d at 1756; that is, if the assertedly equivalent structure performs the claimed function in substantially the same way to achieve substantially the same result as the corresponding structure described in the specification. See 35 U.S.C. § 112, ¶ 6 (means-plus function claim literally covers "the corresponding structure, material, or acts described in the specification and equivalents thereof" (emphasis supplied)).

Applying this test in the instant case, we do not consider that the differences between appellant's disclosed controller, motor and reduction gear set arrangement and Douglas' manually-operated handle and spindle are insubstantial. Douglas therefore does not disclose an equivalent of appellant's structure which corresponds to the claimed "drive means," and consequently does not anticipate claim 26.

Rejection (3) accordingly will not be sustained.

⁵ Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus. Inc., 145 F.3d 1303, 46 USPQ2d 1752 (Fed. Cir. 1998).

Rejection (4)

In making this rejection, the examiner asserts that it would have been obvious to provide the Nolte window latch assembly with a motor and gear reduction in view of Wydler, and further to mount the keeper assembly on the sash and the cams on the jamb, instead of the reverse arrangement disclosed by Nolte, this being a mere reversal of the essential working parts of a device which involves only routine skill in the art (citing In re Einstein, 46 F.2d 373, 8 USPQ 166 (CCPA 1931)).

We agree with the examiner that, in view of Wydler, it would have been obvious to motorize the Nolte apparatus so that the keeper 40 would be moved by a motor acting through a reduction gear set.⁶ However, we do not agree with the examiner that it would have been obvious to locate Nolte's keeper 40 on sash 16, and cams 100, 110 on the jamb 14. While it has been held in such cases as Einstein, supra, In re Gazda, 219 F.2d 449, 452, 104 USPQ 400, 402 (CCPA 1955), and In re Weber, 312 F.2d 810,

⁶ In fact, it appears from page 1, lines 21 to 23 of the specification that such motorized apparatus was already known in the art when the application was filed.

Appeal No. 2000-0078
Application No. 08/837,242

813, 136 USPQ 442, 444 (CCPA 1963), that the reversal of the operation of parts is an obvious expedient, the Court has cautioned that such "obvious expedient" findings must be based upon a determination of obviousness under § 103, and not upon a "mechanical rule." In re Wright, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965). In the present case, it is, first, not apparent to us that putting Nolte's keeper on the sash and cams on the jamb could be accomplished without modification of the parts involved; for one thing, the handle 10 would have to be relocated so that it would not project from the outside of the sash, an obviously undesirable location. Second, appellant argues on page 15 of his brief that it would not have been obvious to locate the movable parts, including the motor, on the sash, in view of the fact that suitable power would have to be provided to the motor. Considering the record as a whole, we conclude that there would have been no motivation for one of ordinary skill to locate the keeper apparatus of Nolte, motorized as suggested by Wydler, on the sash of the window, and thus that

such an arrangement would have been unobvious to one of

Appeal No. 2000-0078
Application No. 08/837,242

ordinary skill in the art.

We therefore will not sustain rejection (4).

Conclusion

The examiner's decision to reject claims 1, 8, 10, 11, 26 and 29 as anticipated by Miilu under 35 U.S.C. § 102 (b) is affirmed as to claims 1, 11, 26 and 29, and reversed as to claims 8 and 10. The examiner's decision to reject claims 1 to 4, 8 to 14 and 25 to 29 on the various other grounds specified herein is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED-IN-PART

	IAN A. CALVERT)	
	Administrative Patent Judge)	
)	
)	
	NEAL E. ABRAMS)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	JENNIFER D. BAHR)	
	Administrative Patent Judge)	
)	

Appeal No. 2000-0078
Application No. 08/837,242

IAC:lmb

IAC:lmb

Appeal No. 2000-0078
Application No. 08/837,242

WOOD, PHILLIPS, VAN SANTEN, CLARK
AND MORTIMER F. WILLIAM McLAUGHLIN
500 WEST MADISON STREET
SUITE 3800
CHICAGO, IL 60661